

REMARKS

Oath/Declaration

At page 4 of the Office Communication requirement for a new oath or declaration is stated. The Office Communication contends that "the oath or declaration is defective because it fails to recite the foreign priority claim made or recited in the application data sheet (ADS)" and that "there is an inconsistency in the foreign priority claim in the oath and the ADS." This contention is respectfully traversed.

A supplemental ADS, identifying all the foreign priority papers and other bibliographic information, was filed with the USPTO on July 14, 2003. The supplemental ADS complies with the provisions under 37 CFR §1.76 (c). With respect to the alleged conflict between the oath/declaration and the ADS regarding the priority claim, the issue is moot in view of the latter-filed supplemental ADS and the information contained therein. See, MPEP §601.05.

More specifically 37 CFR §1.76(d) expressly outlines the provisions for correction of priority claim when there is an inconsistency between application data sheet and other documents.

37 CFR §1.76(d): *Inconsistencies between application data sheet and other documents*

- (1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, or by a §1.63 or §1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;
- (2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by an amendment to the specification, a designation of correspondence address, or a §1.63 or §1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;
- (3) The oath or declaration under §1.63 or §1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41 (a)(1)) and setting forth their citizenship (35 U.S.C. 115);
- (4) The Office will capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally, for example, not look to an oath or declaration under §1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application data sheet containing errors may be corrected if applicant submits a request therefor and a supplemental application data sheet. (Emphasis added)

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